

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s): David K Gifford
Appl. No.: 09/711,511
Conf. No.: 8013
Filed: November 14, 2000
Title: DIGITAL ACTIVE ADVERTISING
Art Unit: 3694
Examiner: Susanna M. Meinecke Diaz
Docket No.: 115274-015

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit Appellants' Reply Brief in response to the Examiner's Answer dated April 23, 2007 pursuant to 37 C.F.R. § 41.41(a). Appellants respectfully submit the Examiner's Answer has failed to remedy the deficiencies with respect to the Final Office Action dated June 22, 2006 as noted in Appellants' Appeal Brief filed on January 29, 2007 for at least the reasons set forth below. Accordingly, Appellants respectfully request that the rejections of pending Claims 1-4 and 23 be reversed.

**II. REGARDING CLAIMS 1, 4 AND 23, A PRIMA FACIE CASE OF
OBVIOUSNESS HAS NOT BEEN ESTABLISHED WITH RESPECT TO THE
COMBINATION OF THE BUSH PATENT AND THE ALANTEC DOCUMENT**

- a. *Bush and Alantec*, alone or in combination, fail to disclose or suggest all of the elements of the claimed invention

Appellant maintains that the cited documents, alone or in combination, do not teach or suggest at least “means for communicating a digital advertisement . . . using Internet transfer protocols” and “means for requesting, displaying and responding to digital advertising [presented using Internet transfer protocols]” as recited in claim 1 and similarly recited in claims 4 and 23.

It is apparent from the Examiner's Answer that there is a fundamental disagreement over the interpretation of the means-plus-function features recited in the present claims. The Appellant provided detailed examples in the opening brief (see, e.g., pages 16-17) of hardware/software structures that supported the “means for communicating a digital advertisement . . . using Internet transfer protocols,” and further cited provisions from the MPEP in support of Appellant's interpretation (see page 18, second paragraph, and page 19). In response, the Examiner's Answer seems to take an “all-or-nothing” approach to the illustrations by interpreting these examples as limitations which Appellant desired to be read into the claims. With all due respect, it appears to the Appellant that only the disclosures in the specification which served the purposes of rejection were considered, while the remaining disclosures were ignored.

For the sake of clarity, the Appellant is certainly not suggesting that the examples be interpreted as claim limitations. The present claims encompass a computer network sales system, where the relevant skill in the art at the time the invention was made would include an experienced computer network designer or engineer. One skilled in the art would understand that “Internet transfer protocols” would require a number of functions, at a minimum, to even allow such communication to take place: a TCP/IP protocol, a UDP protocol, and an application protocol. It is understood in the relevant art that the IP protocol defines the datagrams or packets that carry blocks of data from one node to another, and the TCP protocol allows networked hosts to create connections to one another over which they can exchange streams of data. The UDP protocol allows computers to send short messages (i.e., datagrams) to one another, and the

application protocol defines the specific messages and data formats sent and understood by the applications running at each end of the communication. From the hardware standpoint, a computer must have a device to communicate over a network (e.g., modem) and have ports available to effect the necessary communication.

The examples in Appellant's opening brief (e.g., HTML, URL, HTTP) were provided to show particular embodiments that rely on these protocols, and not to limit the present claims to the cited examples, as suggested by the Examiner. As is explained below, Appellant respectfully argues that no one skilled in the art having common sense (as established by the Supreme Court in *KSR*), would interpret *Bush* as performing any communication that is related to Internet transfer protocols, or packet switched networks. Nevertheless, in an effort to aid the Board in deciding on the current rejection, Appellant will submit that the term "Internet transfer protocols" may be interpreted as "hardware loaded with executable software that allows Internet traffic to flow over a network."

Appellant continues to take issue with the Examiner's position that *Bush* is remotely related to a Internet transfer protocols or packet-switched network communication. The Examiner's Answer continues to suggest that video broadcasting, which includes the loading of information from a computer prior to broadcasting, is somehow related to the claimed features (e.g., "*Bush* transmits video (including related advertisements) over a packet-switched network" (page 9, 3rd paragraph); "*Bush*'s communications may be conducted over a packet-switched network" (page 19, starting 10 lines from the bottom)). In the opening brief, Appellant clearly demonstrated that no such packet-switched communication takes place, since advertisements are loaded into a computer (note: not broadcast to users) using asynchronous transfer and time multiplexing (see Appeal Brief, page 19, last paragraph - page 21, 1st paragraph). Appellant is unaware of any Internet transfer protocol or packet-switched communication that relies on such techniques.

Regarding the "means for requesting, displaying and responding to digital advertising" feature, the specification similarly discloses an Internet-based configuration where buyer computers receive and link HTML forms or documents received from merchants over the Internet (i.e., packet switched network). In contrast, *Bush* discloses a structure utilizing multiple PLL synthesized tuners (215-16), channel control demodulators (217), demodulator data separators (214) and RF switches (213) to request, display and respond to video advertisements

(col. 5, line 45-col. 6, line 9; col. 7, lines 6-21). Again, the Examiner's Answer summarily dismisses this argument by apparently refusing to read any disclosure in the specification into the present claim. Appellant respectfully submits that it would be helpful if the Examiner would identify which elements from the specification are being used to construe the present claims. At the present time, it appears that only the hardware (i.e., the computer, the network) is being considered, to the exclusion of everything else. Applicant submits that such an interpretation, in light of the means-plus-function language and the recited features, is improper. By ignoring the features embodied in software, the Examiner's claim interpretation effectively vitiates the "means for" language, and the benefits it provides.

Moreover, claim 1 recites that the "plurality of buyer computers and at least one merchant computer are *interconnected* by a communications network." Appellant previously argued that, consistent with packet-switched communication, each of the buyer computers can communicate with the merchant computer *and with each other*. The disclosure in the specification supports this interpretation, and the plain meaning of the word is likewise consistent ("to be connected with each other; to connect reciprocally" The American Heritage Dictionary of the English Language, Fourth Edition Copyright © 2006 by Houghton Mifflin Company). Nothing in the disclosure of *Bush* teaches or suggests that the set-top boxes and card readers are "interconnected" with one another in any meaningful way. Appellant submits that it is improper provide unreasonably broad interpretations on claimed features that are inconsistent with the specification.

Regarding independent claim 4, the claim additionally recites means at the buyer computer for displaying and responding to the digital advertisement comprising display means for displaying the digital advertisement by executing a portion of said advertisement as a program and performing actions as specified by the program. *Bush* merely discloses a video menu that is broadcast from the transmitting source 10, along with prompting data that prompts the user to enter a selection on a keypad (col. 3, lines 1-20; col. 8, lines 3-8). The buyer's receiver 26 does not "execute" anything related to the digital advertisement, but merely forwards keypad entries or credit-card swipes to a transaction processor in response to a prompt (col. 3, lines 21-34). Due to the fact that the advertisements are television broadcasts containing video text, there is nothing "executable" about the video advertisements whatsoever. Contrary to the Examiner's Answer, displaying a video broadcast advertisement on a user's television screen

cannot be interpreted as "executing . . . a program," even under the broadest of reasonable interpretations.

Regarding claim 23, the claim expressly recites that "packet-switched" communication is used to provide digital advertisements, and to communicate responses from the buyer computer, and to communicate a purchase message to a merchant computer. No such configuration is disclosed in *Bush*, and the Examiner's Answer has not responded in this regard. As was explained above, *Bush* does not teach packet-switched communication anywhere in the disclosure.

Regarding *Alantec*, aside from teaching video conferencing using Internet transfer protocols, it solves none of the deficiencies of *Bush*, discussed above. Moreover, as will be explained below, there is no apparent reason why one skilled in the art would combine the references in the manner suggested by the Examiner.

- b. There is no apparent reason why one having ordinary skill in the art combine the cited references to arrive at the present claims

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary consideration (e.g., the problem solved). *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, 148 USPQ2d 459, 467 (1966). "[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) *quoting In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *see also DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006) ("The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself."). The analysis supporting obviousness, however, should be made explicit and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements" in the manner claimed. *KSR*, 127 S. Ct. at 1732, 82 USPQ2d at 1389.

Appellant respectfully submits that the Office Action has improperly piecemealed individual features from multiple references to arrive at the present rejection. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR*, 127 S. Ct. at 1732. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). “A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments relying on *ex post* reasoning.” *KSR* 127 S. Ct. at 1740.

The Examiner's Answer posits that “*Alantec* clearly describes an advancement in the art of video distribution” (see page 20). To this, Appellant wholeheartedly agrees - in fact, it is clear from the disclosure in *Alantec* that the advancement is so significant, that *virtually none of the equipment and transmission methods used in Bush are even relevant to the configuration of Alantec*. It is clear that the two disclosures are not analogous and are related to completely different skills in the art (video broadcasting vs. computer networking). *Alantec* discloses an IP multicast routing system where PC's networked within a LAN can submit A/V messages to a central server (PowerHub), which in turn forwards the traffic to a selected group of users “who can simultaneously participate in video conferences, and other interactive desktop applications” (paragraph 6). This clearly has no application to *Bush*, and expressly teaches away from the disclosure. *Alantec* teaches that the PowerHub system allows users to multicast content to a server that processes network connections to stream multimedia traffic to selected network nodes, instead of using unicast and broadcast addressing (paragraphs 5 and 6). In contrast, *Bush* expressly relies on conventional broadcasting to transmit television and video character content to users (see, e.g., claim 1).

As argued previously by Appellant, *Bush* clearly does not rely on any computer networking in the transmitting the broadcasts. In contrast to *Alantec*, *Bush*

(1) does not disclose any type of LAN architecture (*cf.*, *Alantec*, paragraph 3),

- (2) does not disclose the use of personal computers (*cf.*, *Alantec*, paragraph 9),
- (3) clearly does not allow viewers to send video content or advertisements *to each other*, (*cf.*, *Alantec*, paragraph 6)
- (4) expressly relies on standard video channel transmission for broadcast and does not contemplate IP multicasting (*cf.*, *Alantec*, paragraph 6),
- (5) does not rely on servers for transmitting advertisements among users over a network (*cf.*, *Alantec*, paragraph 3), and
- (6) makes no provision whatsoever for IP communication anywhere in the system (*cf.*, *Alantec*, paragraph 8).

A person skilled in the art of video broadcasting would not conceivably contemplate a wholesale restructuring of the configuration of *Bush* to incorporate the teaching of *Alantec*. *Bush* does not disclose packet-switched communication, and further relies upon a multitude of separate transmission channels to enable communication between the various components. Moreover, the transmission of videos and menus in *Bush* are clearly disclosed as occurring on a standard video channel. It is inconceivable that the IP multicasting of *Alantec* could be incorporated into the RF broadcasting system of *Bush* without essentially gutting and replacing most every essential feature contained within *Bush*. If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (MPEP 2143.01).

Because of these differences, one skilled in the art would not modify or combine *Bush* and *Alantec* to arrive at the present claims. Thus, contrary to the Examiner's contentions, a person having ordinary skill in the relevant art would not have been led to the claimed subject matter within the meaning of 35 U.S.C. § 103.

III. THE PATENTABILITY OF CLAIM 1 RENDERS MOOT THE REJECTIONS OF CLAIMS 2 AND 3

Dependent claims 2 and 3 were also rejected under 35 U.S.C. §103(a) as being unpatentable over *Bush* (US Patent 5,475,585) in view of *Alantec*. Appellants respectfully submit that the patentability of independent claim 1 as previously discussed renders moot the

obviousness rejections of claims 2 and 3. In this regard, the cited art fails to teach or suggest the elements of these claims in direct/indirect combination with their respective independent claims

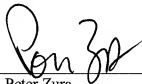
IV. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the Final Office Action. Appellants respectfully submit that the Patent Office has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) with respect to the rejections of Claims 1-4 and 23. Accordingly, Appellants respectfully submit that the obviousness rejections are erroneous in law and in fact and should therefore be reversed by this Board.

No fee is due in connection with this Reply Brief. The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 0115274-015 on the account statement.

Respectfully submitted,

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